

## REMARKS

Reconsideration of the above-identified patent application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-29 are in this case. Claims 1-16 and 19-25 have been rejected under § 102(e). Claims 3, 14, 15, 17, 18 and 25-29 have been rejected under § 103(a). Claims 1, 2 and 19-25 have been canceled. Independent claims 16, 17 and 26 and dependent claims 3-6, 9 and 13-15 have been amended. New claims 30-36 have been added.

The claims before the Examiner are directed toward a portable device for data storage and transfer. The device includes a non-volatile memory for storing the data and an interface that the device uses to exchange data with other, similar devices. In one embodiment of the present invention, the operations of both the device and the similar device with which the device exchanges data are restricted to data storage and transfer. In another embodiment of the present invention, both the device and the similar device with which the device exchanges data lack operating systems. In yet another embodiment of the present invention, the device also includes a memory for storing a software application for controlling the data exchange, and neither the device nor the similar device with which the device exchanges data is capable of receiving an additional software application.

### § 102(e) Rejections – Eichstaedt et al. ‘494

The Examiner has rejected claims 1-6, 16, 19 and 24 under § 102(e) as being anticipated by Eichstaedt et al., US Patent No. 6,563,494 (henceforth, “Eichstaedt et al. ‘494”). The Examiner’s rejection is respectfully traversed.

Claims 1, 2, 19 and 24 have been canceled, thereby rendering moot the Examiner's rejection of these claims.

Eichstaedt et al. '494 teach a stylus 44 for transferring data from one PDA 12 to another PDA 14. Like the portable devices of the present invention, stylus 44 includes a non-volatile memory (in data storage device 52) for storing the data and an interface (transceiver 50) for transferring the data. Also like the portable devices of the present invention, stylus 44 only stores and transfers data, and has no other functionality.

The crucial difference between the present invention and stylus 44 is that stylus 44 is capable only of transferring data among PDAs such as PDAs 12 and 14. Styli 44 are incapable of exchanging data directly among themselves. By contrast, the portable devices of the present invention are configured to exchange data directly among themselves, using their interfaces. Thus, the present invention is not anticipated by Eichstaedt et al. '494. Furthermore, the present invention is not obvious from Eichstaedt et al. '494. The only purpose of stylus 44 is to transfer data from one PDA to another. There is neither a hint nor a suggestion in Eichstaedt et al. '494 that any useful purpose would be served by configuring styli 44 to exchange data directly among themselves.

While continuing to traverse the Examiner's rejections, Applicant has, in order to expedite the prosecution, chosen to amend independent claim 16 in order to clarify and emphasize the crucial distinctions between the present invention and the device of Eichstaedt et al. '494. Specifically, the reference in the preamble of claim 16 to a "second portable device" has been changed to a reference in the body of claim 16 to "another portable device" with which the device exchanges data via its device interface, and the final limitation of the claim has been applied to both portable

devices. Support for this amendment is found in Figure 2, which shows two substantially identical portable devices, devices 12 and 32, exchanging data via their device interfaces 16. Support for characterizing the purpose of the system in the preamble of claim 16 as being for data storage for a user is found in the preamble of claim 1 as filed.

In addition, the final limitation of claim 16 has been modified to state that the operations of the two portable devices are restricted to data storage and transfer. Support for this amendment is found in the specification on page 5 lines 3-7:

The operations of the device are restricted, in order to increase the ease of use of the device, and in order to provide certain core functions. These core functions include reading data, writing data and exchanging data with a similar device and/or with an external computer.

Amended independent claim 16 now features language which makes it absolutely clear that the present invention is capable of exchanging data with other, similarly restricted devices, and not just with more powerful devices such as PDAs. Applicant believes that the amendment of the claims completely overcomes the Examiner's rejections on § 102(e) grounds.

In addition to the amendment of claim 16, new claims 30-33 have been added, and claims 3-6, 9 and 13-15 have been amended so that claims 3-15 depend from claim 16 rather than from claim 1. Essentially, these additional amendments replace independent claim 1 with independent claim 16 as the independent claim from which claims 3-15 depend.

New claim 30 adds to claim 16 the limitation, formerly recited in claim 1, that the portable device includes a logic for executing at least one instruction for controlling the transfer of the data.

New claim 31 adds to claim 30 the limitation, formerly recited in claim 1, that the instructions are not alterable by the user.

New claim 32 adds to claim 16 the limitation, formerly recited in claim 1, that the portable devices communicate only through their device interfaces.

New claim 33 adds to claim 16 the limitation, also recited in claim 17 as filed and stated in the specification on page 7 line 6, that the portable device lacks an operating system.

With independent claim 16 allowable in its present form, it follows that claims 3-6 and 30-33, that depend therefrom, also are allowable.

**§ 102(e) Rejections – Eberhard et al. ‘131 and Dickie ‘206**

The Examiner has rejected claims 16, 23 and 24 under § 102(e) as being anticipated by Eberhard et al., US Patent Application Publication No. 2003/0056131 (henceforth, “Eberhard et al. ‘131”). The Examiner has rejected claims 1, 6-16 and 19-25 under § 102(e) as being anticipated by Dickie, US Patent Application Publication No. 2003/0041206 (henceforth, “Dickie ‘206”). The Examiner’s rejection is respectfully traversed.

Claims 1 and 19-25 have been canceled, thereby rendering moot the Examiner’s rejection of these claims.

Both Eberhard et al. ‘131 and Dickie ‘206 teach aspects of direct data exchange among electronic devices. Eberhard et al. ‘131 teach a method by which a laptop computer **110** conserves power while exchanging data directly with a PDA **150**. Dickie ‘206 teaches a laptop computer **104** that includes a cradle **120** for facilitating direct data exchange with a PDA **102**. The crucial difference between the portable devices of the present invention and the electronic devices of Eberhard et al. ‘131 and Dickie ‘206 is that the electronic devices of Eberhard et al. ‘131 and Dickie ‘206 all have far more functionality than the portable device of the present invention. The functionality of a PDA is described by Dickie ‘206 in paragraph 0003 as follows:

A PDA is a compact device that can serve various functions including a cellular phone, facsimile transmitter, personal organizer, and the like. PDAs typically include a stylus and/or a touch screen for user input, and may include a keyboard or a limited number of input keys. PDAs can be used for such things as sending and retrieving e-mail, Web browsing, and data-sharing applications over the Internet, intranet or corporate networks. (emphasis added)

A laptop computer has even more functionality than this. By contrast, the functionality of the portable device of the present invention, as recited in claim 16, is limited to data storage and transfer.

Thus, the present invention, as recited in claim 16, is not anticipated by either Eberhard et al. '131 or Dickie '206. Furthermore, the present invention, as recited in claim 16, is not obvious from Eberhard et al. '131 and Dickie '206, either separately or in combination. There is neither a hint nor a suggestion in Eberhard et al. '131 or Dickie '206 of any reason to remove, from an electronic device such as a PDA, all of its extensive functionality except for data storage and transfer.

With independent claim 16 allowable in its present form, it follows that claims 6-15, that depend therefrom, also are allowable.

#### **§ 103(a) Rejections – Eichstaedt et al. '494**

The Examiner has rejected claims 3, 14, 15, 17, 18 and 25-29 under § 103(a) as being unpatentable over Eichstaedt et al. '494. The Examiner's rejection is respectfully traversed.

Claim 25 has been canceled, thereby rendering moot the Examiner's rejection of this claim.

It is demonstrated above that independent claim 16 is allowable over Eichstaedt et al. '494 in its present form. It follows that claims 3, 14 and 15, that depend therefrom, also are allowable.

As discussed above, there is neither a hint nor a suggestion in Eichstaedt et al. '494 of any utility to configuring styli 44 to exchange data directly among themselves. It follows that it does not matter whether styli 44, like the portable devices of the present invention as recited in claim 17, lack operating systems, or whether styli 44, like the portable devices of the present invention as recited in claim 26, cannot receive additional software. The portable devices of the present invention, which are configured to exchange data directly among themselves, are not obvious from Eichstaedt et al. '494. Therefore, claims 17 and 26 have been placed in condition for allowance by amending claims 17 and 26, similar to the amendment of claim 16, to state that the portable device transfers data to another portable device that shares one of the limitations of the portable device. In the case of claim 17, this limitation is that both portable devices lack an operating system. In the case of claim 26, this limitation is that neither portable device is capable of receiving an additional software application. Support for this amendment is found in the specification in Figure 2, as discussed above.

With independent claims 17 and 26 allowable in their present form, it follows that claims 18 and 27-29, that depend therefrom, also are allowable.

#### **Other New Claims**

New claims 34-36 also have been added.

New claims 34-36 are claims 16, 17 and 26, as amended, rewritten to recite the present invention as a system that includes a plurality of portable devices. Support for describing the present invention as a system that includes a plurality of portable devices is found in Figure 2, which shows two portable devices 12 and 32 of the present invention.

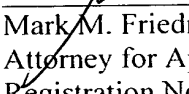
**Amendments to the Specification**

An inadvertent typographical error on page 14 line 16 has been corrected.

No new matter has been added.

In view of the above amendments and remarks it is respectfully submitted that independent claims 16, 17, 26 and 34-36, and hence dependent claims 3-15, 18 and 27-33 are in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



---

Mark M. Friedman  
Attorney for Applicant  
Registration No. 33,883

Date: December 4, 2003